

## **REMARKS**

Claims 1-9 are pending in the present application. By this Response, claims 1 and 7 are amended and claims 10-21 are canceled. Independent claims 1 and 7 are amended to recite additional features of the present invention. Support for the addition of the features in claims 1 and 7 may be found at least at page 10, lines 19-26; page 11, lines 1-7; and Figure 2, elements 220 and 224. No new matter has been added by the amendment to claim 1. Reconsideration of the claims is respectfully requested in view of the following remarks.

Applicants have amended claims 1 and 7, and canceled claims 10-21 from further consideration in this application. However, Applicants are not conceding in this application that the unamended claims or the canceled claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the application. Applicants respectfully reserve the right to pursue the unamended claims, canceled claims, and any other claims in one or more continuations and/or divisional patent applications.

### **I. Telephone Interview**

Applicants attempted to contact Examiner Park numerous times and left numerous messages requesting the scheduling of a telephone interview to discuss the above claim amendments and following remarks. None of Applicants' messages were returned and Applicants were not able to schedule the telephone interview prior to the filing due date of this Response. Accordingly, Applicants respectfully request that the Examiner contact Applicants' undersigned representative to discuss the merits of this application prior to taking further action.

### **II. Rejection Under 35 U.S.C. § 103(a) Based on Feria and Hack**

The Office Action rejects claims 1, 3-5, 7, 8, 10, 12-14, 16, and 18-20 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Feria et al. (U.S. Patent No.

7,020,621) in view of Hack et al. (U.S. Patent Application Publication No. 2003/0187707). This rejection is moot with regard to canceled claims 10, 12-14, 16, and 18-20 and is respectfully traversed with regard to claims 1, 3-5, 7, and 8.

Amended claim 1, which is representative of claim 7 with regard to similarly recited subject matter, reads as follows:

1. A method of simulation, said method comprising:
  - receiving, for at least one business transformation outsourcing service, spending inputs, process inputs, and information technology inputs;
  - based on said inputs, performing a spending simulation, a process simulation, and an information technology simulation;
  - computing net savings values, based on said simulations;
  - performing a value simulation, based on said net savings values;
  - and
    - outputting at least one measure of economic value for said business transformation outsourcing service, wherein:
      - the spending simulation, process simulation, information technology simulation, and the value simulation have a plurality of periods of simulation,
      - the process simulation, based on the inputs, computes a number of transactions during each period of simulation, of the plurality of periods of simulation, and a process cost, based on a status of the particular period being under current conditions, transitional conditions, or during outsourcing conditions,
      - the information technology simulation simulates, based on the inputs, the tasks needed to design, build, implement, operate, and maintain new information technology to implement the outsourcing, and computes a transformation cost for each period of the simulation, of the plurality of periods of simulation, based on the status of the particular period being under current conditions, transitional conditions, or during outsourcing conditions,
      - an output of the spending simulation, the processing savings, and the information technology transformation costs are combined to identify the net savings values representing a transition from current conditions to outsourcing conditions,
      - the value simulation simulates, based on the net savings and business financial input information, effects of transitioning from current conditions to outsourcing conditions, on a financial position of the business, and
      - the at least one measure of economic value for the business transformation outsourcing service is calculated based on the effects of

transitioning from current conditions to outsourcing conditions on the financial position of the business.  
(emphasis added)

Applicants respectfully submit that neither Feria nor Hack, whether taken alone or in combination, teaches or suggests the features of claim 1 emphasized above or the similar features found in independent claim 7.

Feria is directed to a mechanism for determining a total cost per user, i.e. a base cost and an ongoing cost, of ownership of information technology (IT) in a distributed computing environment. The base costs measure the “one off” costs of implementing the base system and network infrastructure. These costs consist of the planning costs (labor expenses), the acquisition costs (hardware and software purchase), which are typically Capital costs, and the installation costs (labor expenses). The ongoing costs measure the total amount of expense since the IT infrastructure has been running. The costs are categorized as direct and indirect costs. The direct costs the day-to-day operational costs such as maintenance, support, monitoring, etc., whereas the indirect costs pertain to the unbudgeted costs that are caused either by downtime or end-user inefficiency at work. The direct costs are hard factual costs whereas the indirect costs are soft costs because they are more subjective (column 3, lines 1-18).

With the mechanism of Feria, a user may provide various inputs for various costs CD1 to CD44 in Figure 1 that are detailed out in columns 4-10. The various costs are combined according to a standardized template (column 10, lines 39-44) to generate metrics 24, 26, and 28 in Figure 1. The metrics are used compute ratios that are then organized by topic (column 10, lines 45-49). The various ratios of metrics are defined in columns 10-28.

While Feria discusses generating various cost metrics and ratios of costs metrics, nowhere in Feria are the specific operations set forth in claim 1 emphasized above taught or suggested by Feria. Specifically, nowhere in Feria is there any teaching or suggestion regarding “outputting at least one measure of economic value for said business transformation outsourcing service.” Feria is not concerned with determining a measure of economic value for transforming a business to use outsourcing. To the contrary, Feria is concerned with determining the total cost of ownership of an IT infrastructure and thus,

is concerned with determining the cost of the current IT condition. Feria does not provide any teaching or suggestion regarding any simulations to determine an economic value of transforming a business to use outsourcing.

Furthermore, Feria does not teach or suggest that a process simulation computes a number of transactions during each period of simulation and a corresponding process cost, based on a status of the particular period being under one of current conditions, transitional conditions, or during outsourcing conditions, as recited in claim 1. In Feria, there is a determination as to help desk call handling rate and staffing ratios in which the inputs are the number of calls presented to the help desk and the total number of help desk tier 1 staff, but there is no computation of a number of transactions during each period of simulation based on the status of the particular period being either a current condition, transitional condition, or outsourcing condition. Again, Feria is not concerned with determining a measure of economic value for transforming a business to use outsourcing. Thus, Feria is not concerned with whether a particular period of a simulation occurs during current conditions, a transitional condition, or an outsourcing condition. Hence, Feria does not provide any teaching or suggestion to compute a number of transactions during each period of simulation and a corresponding process cost based on the particular period being under one of current conditions, transitional conditions, or outsourcing conditions.

Similarly, Feria does not teach that an information technology simulation simulates the tasks needed to design, build, implement, operate, and maintain new information technology to implement the outsourcing, and computes a transformation cost for each period of the simulation based on the status of the period being under one of current conditions, transitional conditions, or during outsourcing conditions, as recited in claim 1. While Feria uses cost inputs regarding an IT infrastructure which may include design costs, build costs, etc., Feria does not compute a transformation cost for each period of a simulation. Moreover, Feria does not compute a transformation cost for each period of a simulation based on the particular period being under one of current conditions, transitional conditions, or outsourcing conditions. Again, this is because Feria is not concerned with determining the economic benefit of transitioning a system to

outsourcing but instead is merely concerned with the costs of maintaining a current IT infrastructure.

Moreover, Feria does not teach or suggest combining business benefits savings, processing savings, and information technology transformation costs to identify a net savings of transitioning from current conditions to outsourcing conditions, as recited in claim 1. While Feria teaches many different ways to combine cost inputs to generate metrics which may then be used to calculate ratios of metrics, Feria does not teach or suggest the particular combination of costs recited in claim 1 to identify a net savings of transitioning from current conditions to outsourcing conditions. This is because Feria is concerned with costs of maintaining a current IT infrastructure and not concerned with costs associated with transitioning from a current IT infrastructure to a system of outsourcing.

In addition, Feria does not teach or suggest that a value simulation simulates, based on the net savings and business financial input information, effects of transitioning from current conditions to outsourcing conditions, on a financial position of the business. Since this feature of claim 1 builds off of the previous features discussed above that are not taught or suggested by Feria, this feature cannot be taught or suggested by Feria either. Moreover, nowhere in Feria is there any teaching or suggestion to simulate the effects of transitioning from current conditions to outsourcing conditions, which are based on the net savings determined by simulating the periods based on whether the period is under current conditions, transitional conditions, or outsourcing conditions, on a financial position of the business.

Lastly, Feria fails to teach or suggest that at least one measure of economic value for the business transformation outsourcing service is calculated based on the effects of transitioning from current conditions to outsourcing conditions on the financial position of the business. Again, Feria is not concerned with the transitioning of a business from current conditions to outsourcing conditions and thus, cannot teach or suggest that a measure of economic value for a business is calculated based on the effects of such a transition on the financial position of the business.

Hack, likewise, does not teach or suggest the features discussed above. Hack is directed to a mechanism for deriving relevant business processes by providing a set of

business processes based on a user's selection of an industry and a market participant and then identifying a subset of the business processes through a transformation strategy method, a business goals method, and a program solutions method. The mechanism of Hack includes an opportunity assessment function 22a which may allow identification of value-added business processes and/or strategies (see paragraph [0025]). Identifying value-added strategies may involve defining transformation strategies which are presented to a user along with proposed complementary strategies that will produce a shortlist of relevant and value-added business strategies for a user. The user may select for further analysis one or more strategies from a list of strategies recommended by the system (see paragraph [0026]). As an example of this, Hack provides a situation in which a user who is a manufacturer of consumer products may select for further analysis, the transformation strategy "customer self-service" and in response, the system may provide and describe "complementary business strategies" such as "one-to-one customer interaction" or "customer life-cycle management." The user may then identify which method is most appropriate for their business.

Based on the value-added business strategies selected by the user, a C-Business Map, such as shown in Figure 4 of Hack, may be generated. As part of the generation of such a view of the business strategies selected by the user, the collaborative solutions opportunities function may identify information technology (IT) tasks required to implement the solutions and determine an array of potential implementations to facilitate those tasks (see paragraph [0033]). A value calculation function may calculate the value of the strategies selected by the user. The user may input what they are interested in obtaining information about regarding potential value or savings and a corresponding report may be generated (see paragraph [0034]).

Essentially, what Hack teaches is a system in which a user may select a particular market or industry (e.g., consumer goods) and a market participant (e.g., distributor) and be presented with a group of possible business processes that the selected market participant may implement within the selected market. The user may then select the business processes that are of interest to him/her using one or more of three different mechanism, transformational strategies, business goals and objectives, or program solution. The transformational strategies mode lists the strategies based on the type of

service that the market participant may wish to implement, e.g., “customer self-service.” The business goals and objectives mode allows the user to select business processes listed according to the type of result obtained, e.g., “reduce inventory costs.” The program solutions mode allows the user to select business processes based on a particular business issue being addressed.

The particular business processes presented are particular to the market and the market participant selected by the user. However, the information provided by Hack, as shown in Figure 4, is only general information identifying the benefits and potential values of implementing such business processes in the particular market by the particular market participant. Hack does not provide any teaching or suggestion to simulate a transition of a business from current conditions to an outsourcing condition. In fact, Hack does not teach or suggest simulation at all. Hack is directed to simply providing a quick and dirty view of business benefits and values of different business processes for different markets and market participants. Hack does not perform any simulation at all but merely generates a graphical view of the business processes selected by a user and their corresponding general business benefits and values.

Thus, Hack, like Feria, does not teach or suggest the specific simulations over a plurality of periods of simulation, as set forth in claim 1. Moreover, Hack does not provide any teaching or suggestion regarding performing such simulations based on a status of the particular periods being simulated being under one of current conditions, transitional conditions, or outsourcing conditions. This is because Hack is only concerned with providing a view of the general benefits and value for selected business processes for a selected market and market participant. Hack is not concerned with actually simulating a transition from a business under current conditions to a business under outsourcing conditions.

In addition, Hack does not teach or suggest computing a transformation cost for each period of simulation, of the plurality of periods of simulation, based on the status of the particular period being under one of current conditions, transitional conditions, or during outsourcing conditions, as recited in claim 1. While Hack has some information about general values of particular business processes to a particular market, Hack does not provide any teaching or suggestion to perform computation of transformation costs

for each period of a simulation, let alone performing such computations based on whether the particular period being under one of current conditions, transitional conditions, or outsourcing conditions. Furthermore, as with Feria, Hack fails to teach combining business benefits savings, processing savings, and information technology transformation costs to generate a net savings of transitioning from current conditions to outsourcing conditions or simulating effects of transitioning from current conditions to outsourcing conditions, on a financial position of the business and using these effects to calculate at least one measure of economic value for a business transformation outsourcing service.

Since neither Feria nor Hack teach or suggest these features of claim 1, any alleged combination of Feria and Hack, even if such a combination were possible and one were somehow motivated to attempt such a combination, *arguendo*, would not result in the invention as recited in claim 1. Thus, for the reasons set forth above, Applicants respectfully submit that neither Feria nor Hack, whether taken alone or in combination, teach or suggest the features of independent claim 1. Claim 7 recites similar features to that of claim 1 and thus, is allowable over the alleged combination of Feria and Hack for similar reasons. Moreover, at least by virtue of their dependency on claims 1 and 7, respectively, Applicants respectfully submit that the alleged combination of Feria and Hack also fails to teach or suggest the features of dependent claims 3-5 and 8. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-5, 7, and 8 under 35 U.S.C. § 103(a).

### **III. Rejection Under 35 U.S.C. § 103(a) Based on Feria, Hack and Sarno**

The Office Action rejects claims 2, 9, 11, and 17 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Feria et al. (U.S. Patent No. 7,020,621) in view of Hack et al. (U.S. Patent Application Publication No. 2003/0187707) and further in view of Sarno (U.S. Patent Application Publication No. 2002/0042751). This rejection is moot with regard to canceled claims 11 and 17, and is respectfully traversed with regard to claims 2 and 9.

Claims 2 and 9 depend from claims 1 and 7, respectively, and thus, incorporate the features of claims 1 and 7 by virtue of their dependency. Thus, the same distinctions



discussed above with regard to claims 1 and 7, and the Feria and Hack references, applies to claims 2 and 9 as well. Furthermore, the Sarno reference fails to teach or suggest any of the features missing from Feria and Hack as discussed above. Sarno is cited as allegedly teaching outputting yearly summarized cost quantities and benefit quantities for recommending business transformation outsourcing services. Even if this were true, Sarno still fails to teach or suggest the specific features discussed at length above with regard to claims 1 and 7. Thus, any alleged combination of Sarno with Feria and Hack, even if such a combination were possible and one were somehow motivated to attempt such a combination, *arguendo*, would not result in the invention as recited in claims 2 and 9 being taught or suggested. Thus, claims 2 and 9 are allowable over the alleged combination of Feria, Hack, and Sarno at least by virtue of their dependency on claims 1 and 7, respectively. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2 and 9 under 35 U.S.C. § 103(a).

#### **IV. Rejection Under 35 U.S.C. § 103(a) Based on Feria, Hack and Kruk**

The Office Action rejects claims 6, 15, and 21 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Feria et al. (U.S. Patent No. 7,020,621) in view of Hack et al. (U.S. Patent Application Publication No. 2003/0187707) and further in view of Kruk et al. (U.S. Patent No. 7,165,036). This rejection is moot with regard to canceled claims 15 and 21, and is respectfully traversed with regard to claim 6.

Claim 6 depends from claim 1 and thus, incorporates the features of claim 1 by virtue of its dependency. Thus, the same distinctions discussed above with regard to claim 1 and the Feria and Hack references applies to claim 6 as well. Furthermore, the Kruk reference fails to teach or suggest any of the features missing from Feria and Hack as discussed above. Kruk is cited as allegedly teaching making net savings values at least partly dependent upon compliance with standard processes. Even if this were true, Kruk still fails to teach or suggest the specific features discussed at length above with regard to claim 1. Thus, any alleged combination of Kruk with Feria and Hack, even if such a combination were possible and one were somehow motivated to attempt such a combination, *arguendo*, would not result in the invention as recited in claim 6 being

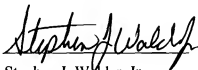
taught or suggested. Thus, claim 6 is allowable over the alleged combination of Feria, Hack, and Kruk at least by virtue of its dependency on claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 6 under 35 U.S.C. § 103(a).

V. **Conclusion**

It is respectfully urged that the subject application is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: July 8, 2008



Stephen J. Walder, Jr.  
Reg. No. 41,534

**WALDER INTELLECTUAL PROPERTY LAW, P.C.**  
P.O. Box 832745  
Richardson, TX 75083  
(214) 722-6419  
ATTORNEY FOR APPLICANTS